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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/673,041	09/25/2003	Jerome Sohler	05032-00032	8052
22910	7590	05/08/2006	EXAMINER	
BANNER & WITCOFF, LTD. 28 STATE STREET 28th FLOOR BOSTON, MA 02109-9601			YOON, TAE H	
			ART UNIT	PAPER NUMBER
			1714	

DATE MAILED: 05/08/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/673,041

Applicant(s)

SOHIER ET AL.

Examiner

Tae H. Yoon

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 21 February 2006.  
2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.  
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-7, 10, 11 and 13-26 is/are pending in the application.  
4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.  
6) ☒ Claim(s) 1-7, 10, 11 and 13-26 is/are rejected.  
7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.  
8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.  
10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☒ All b) ☐ Some \* c) ☐ None of:  
1. ☒ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)  
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)  
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.  
4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_.  
5) ☐ Notice of Informal Patent Application (PTO-152)  
6) ☐ Other: \_\_\_\_\_.

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The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1-7, 10, 11 and 13-26 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

This is New Matter rejection since the recited "apparatus" in claim 1 does not have support in the originally filed specification. Note that a medical device, not an apparatus, is taught throughout the specification.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 2-7, 10, 11, 13, 14 and 20-26 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The recited preamble "a coating according to claim 1" of claim 2 and other claims lacks an antecedent basis since claim 1 recites "an apparatus".

The recited "the additive" in claims 10 and 11 lacks an antecedent basis.

The recited "a biologically active agent" in claim 18 is redundant since claim 1 already recites said biologically active agent.

Te recited "a medical device" in claims 20, 21, 25 and 26 fails to further limit claim 1 wherein an apparatus is claimed.

The recited "adhesion of tissues" as a medical device in claim 21 is confusing and indefinite.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-7, 10, 11, 13, 14 and 20-26 are rejected under 35 U.S.C. 103(a) as obvious over Bakker et al (US 5,480,436) in view of WO 01/10478 and Bakker et al (US 2002/0095213 A).

Rejection is maintained for reason of record with following response.

Applicant asserts that WO is directed to gel-molded copolymer solid bodies and thus combination of references lacks motivation. But, the examiner disagrees with such assertion since Bakker et al (US'436) teach the use of polyethylene glycol terephthalate derivatives at cols. 8 and 9 wherein structures encompassing the instant molecular weight are taught. Thus, one of ordinary skill in the art would recognize the use of the copolymer having the instant weight average molecular weight also taught by WO and Bakker et al (US'213).

Applicant asserts that Bakker et al (US'436) only teach a device comprising a copolymer coated on another layer of copolymer, but not on metals, ceramics, or glasses, but the copolymer layer of Bakker et al (US'436) meets the instant polymeric materials as the surface. Said metals, ceramics and glasses are not needed when the surface is polymeric materials.

Applicant asserts that there is no motivation to combine Bakker et al (US'436) and Bakker et al (US'213), but see above response with respect to the structures encompassing the instant molecular weight of Bakker et al (US'436). Bakker et al (US 2002/0095213 A) teach the same structure taught by Bakker et al (US'436). And thus the use of copolymer having the instant molecular weight of Bakker et al (US 2002/0095213 A) in Bakker et al (US'436) is a *prima facie* obviousness.

WO teaches employing various proteins and other biologically active agents and thus the use of biologically active agents such as antimicrobial agents of WO in order to prevent infections in the layer of Bakker et al (US'436) would be a *prima facie* obviousness since it is a routine practice in medical devices.

Claims 1-7, 10, 11 and 13-26 are rejected under 35 U.S.C. 103(a) as obvious over Bakker et al (US 2002/0095213 A) in view of Bakker et al (US 5,480,436), Goedemoed et al (US 5,980,948), WO 01/10478 or EP 0 830 859.

Rejection is maintained for reason of record with following response.

Applicant asserts that the examiner failed to provide any evidence of surface being cleaned before coating. However, cleaning of the surface of the substrate before

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coating in order to obtain a better adhesion between coating and surface is a routine practice in the coating art and it is an obvious practice. Anyone who has painted anything such as doors, walls or windows of a house knows that clean surfaces provide a better painting and adhesion.

Secondary references teach employing various proteins and other biologically active agents and thus the use of biologically active agents such as antimicrobial agents in order to prevent infections in the device of Bakker et al (US'213) would be a *prima facie* obviousness since it is a routine practice in medical devices.


Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tae H. Yoon whose telephone number is (571) 272-1128. The examiner can normally be reached on Mon-Thu.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vasu Jagannathan can be reached on (571) 272-1119. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
Tae H Yoon  
Primary Examiner  
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THY/May 3, 2006